

## REMARKS

Applicants appreciate the Office Action of February 12, 2003. Applicants have amended Claims 8, 18 and 28 to address objections in the Office Action related to the term "wild card" and submit that the objections with respect to these claims have been obviated. Furthermore, Applicants submit that Amended Claims 1, 11 and 21 and the claims that depend therefrom are patentable over the cited references for at least the reasons discussed below. Applicants have added new Claims 31-36. Applicants submit that the pending claims and the new claims are patentable over the cited references and are in condition for allowance, which is respectfully requested in due course.

### **Claims 8, 18 and 28 are Consistent with Claims 5, 15 and 25 and the Specification**

The Office Action objects to Claims 5, 8, 15, 18, 25 and 28 because the "term 'wild card' in claims 5, 15, 25 do [sic] not follow the same format as the term 'wildcard' in claims 8, 18, 28." *See* Office Action, page 1, paragraph 1. Applicants have amended Claims 8, 18 and 28 to conform to the two word usage of the term 'wild card' used in Claims 5, 15 and 25. Accordingly, Applicants submit that the inconsistency with respect to the format of the term "wild card" objected to in the Office Action has been obviated.

### **Amended Independent Claims 1, 11 and 21 are Patentable Over Merriman**

Claims 1, 2, 11, 12, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 5,948,061 to Merriman *et al.* (hereinafter "Merriman"). Applicants respectfully submit that many of the recitations of these claims are neither disclosed nor suggested by the cited reference. For example, Amended Claim 1 recites:

In a networked environment, a method for designating client properties comprising:

**receiving a link element associated with a server, the link element including a plurality of requested client properties;**

selecting said link element to request a document identified by the link element to be transmitted to a client;

**inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by**

**the link element based on the inserted at least one of said plurality of requested client properties.**

Claims 11 and 21 contain corresponding system and computer program product claims. Applicants submit that at least the highlighted portions of, for example, Amended Claim 1, are neither disclosed nor suggested by Merriman.

The Office Action states that Merriman teaches all the recitations of, for example, Claim 1. *See* Office Action, page 1, paragraphs 2-6. The cited portion of Merriman recites, in part:

In FIG. 1, a user operates a web browser, such as Netscape or Microsoft Internet Explorer, on a computer or PDA or other Internet capable device 16 to generate through the hypertext transfer protocol (HTTP) 14 a request 20 to any one of preferably a plurality of affiliate web sites 12. The affiliate web site sends one or more messages back 22 using the same protocol. **Those messages 22 preferably contain all of the information available at the particular web site 12 for the requested page to be displayed by the user's browser 16 except for one or more advertising objects such as banner advertisements.** These objects **preferably do not reside** on the affiliate's web server. Instead, the affiliate's web **server sends back a link** including an IP address for a node running an advertiser server process 19 as well as information about the page on which the advertisement will be displayed. The link by way of example may be a hypertext markup language (HTML) <img> tag, referring to, for example, an inline image such as a banner. The user's browser 16 then **transmits a message 23** using the received IP address to access such an object indicated by the HTML tag from the advertisement server 19. **Included in each message 23 typically to the advertising server 19 are:** (i) the user's IP address, (ii) a cookie if the browser 16 is cookie enabled and stores cookie information, (iii) a substring key indicating the page in which the advertisement to be provided from the server is to be embedded, and (iv) MIME header information indicating the browser type and version, the operating system of the computer on which the browser is operating and the proxy server type. Upon receiving the request in the message 23, the advertising server process 19 determines which advertisement or other object to provide to user's browser and transmits the messages 24 containing the object such as a banner advertisement to the user's browser 16 using the HTTP protocol. **Preferably contained within the HTTP message is a unique identifier for the advertiser's web page appropriate for the advertisement.** That advertisement object is then displayed on the image created by the web user's browser as a composite of the received affiliate's web page plus the object transmitted back by the advertising web server.

*See* Merriman, column 3, lines 24-63. In other words, a user selects a hyperlink presented on a browser, for example, Netscape, and the browser retrieves all of the information available at the web site, for example, a requested document, except for certain advertising objects. Once

all the available information is obtained, the browser transmits a message 23 to an advertising server that uses the information provided in the message 23 to attach an advertisement to the requested information (requested document) that may be tailored for the specific user or computer. Thus, the advertisement, not the requested information, is tailored to the user/computer based on the information provided in the message 23.

As further recited in Merriman:

As part of the "click through" process, when the user clicks on the banner or other advertising object displayed by the user's browser 16, the user's browser again transmits a message to the ad server. The ad server notes the address of the computer of the browser (or any other identifier such as a cookie or a digital signature) that generated the message 23 and transmits back the URL of the advertiser's web page so that the user's web browser 16 generates a message 26 to contact the advertiser's web site. 18. The ad server process 19 also notes that a "click through" for an advertisement has occurred and updates the various databases in the manner described below. In the above scenario for the click through process, the ad server process

*See* Merriman, column 3, line 64 through column 4, line 11. In other words, a database management company, for example, Double Click, maintains databases including user/computer specific information. Each user/computer is assigned an identifier. The user's activities are then monitored by, for example, tracking the users click stream data, *i.e.* what web sites a user visits, what information is accessed from those websites and the like. This information is stored in a database referenced by the identifier and may also be used to tailor the advertisements presented on the user's display. Accordingly, Merriman discusses a method of tailoring advertisements placed on or around requested documents/information on a display based on information provided by the user and/or a user's web activities.

In contrast, Amended Claim 1, for example, recites receiving a link element associated with a server, the link element including a plurality of requested client properties and inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties. Nothing in Merriman discloses or suggests at least these recitations of Claims 1, 11 and 21. The cited portion of Merriman set out above discusses a server that sends a link back to the browser including an IP address for a node running an advertiser server process as well as information about the page on which the advertisement will be displayed and a user's browser that transmits a message to the advertising server. Nothing in the cited portion of Merriman discloses or

suggests receiving a link element from the server including a plurality of requested client properties, inserting at least one of these requested client properties into a request and using the at least one requested client properties to customize the requested document. In fact, it appears as if the message 23 of Merriman includes information stored in a user profile or cookie and that the information in this user profile or cookie is dumped into the message 23. In contrast, the claims of the present invention recite receiving a link element including a plurality of requested client properties at least one of which is inserted into a request so as to allow customization of the requested document. Thus, according to embodiments of the present invention the server receives only the information it requests, not a dump of all the information stored at the browser. Furthermore, as discussed above, Merriman discusses customizing advertisements to the user and/or computer. In contrast the present invention discusses customizing, for example, the format of the requested document to be compatible with, for example, the client device.

Accordingly, Applicants respectfully submit that Amended Independent Claims 1, 11 and 21 are not anticipated by the cited reference for at least the reasons discussed above. Thus, Independent Claims 1, 11 and 21 are patentable over the cited reference. Furthermore, the dependent claims are patentable at least per the patentability of Independent base Claims 1, 11 and 21 from which they depend. Accordingly, Applicants submit that Independent Claims 1, 11 and 21 and the claims that depend therefrom are in condition for allowance, which is respectfully requested in due course.

**The Dependent Claims are Patentable at least per the Patentability of the Base Claims**

Claims 3, 13 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman. *See* Office Action, pages 2-3, paragraphs 10-14. Claims 4, 5, 14, 15, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of United States Patent No. 6,401,085 to Gershman (hereinafter "Gershman"). *See* Office Action, page 3, paragraphs 15-18. Claims 6, 7, 10, 16, 17, 20, 26, 27 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of United States Patent No. 6,098,081 to Heidorn *et al.* (Hereinafter "Heidorn"). *See* Office Action, pages 4-5, paragraphs 19-27. Claims 8, 9, 18, 19, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Gershman. *See*

Office Action, pages 5-6, paragraphs 28-31. Applicants respectfully submit that Dependent Claims 3-10, 14-20 and 24-30 are patentable at least per the patentability of Independent base Claims 1, 11 and 21 from which they depend.

**Many of the Dependent Claims are Independently Patentable**

As discussed above, the dependent claims are patentable over the cited references at least per the patentability of the independent base claims from which they depend. Many of the dependent Claims are also independently patentable.

For example, Claim 4 recites, "wherein said plurality of requested client properties includes at least one property that is a wild card." Claims 14 and 24 contain corresponding system and program product recitations. As discussed above with respect to Claims 1, 11 and 21, nothing in the cited references discloses or suggests receiving a link element including a plurality of requested client properties, thus, it follows that nothing in the cited references discloses or suggests that the plurality of requested client properties is a wild card as recited in Claims 4, 14 and 24. Accordingly, Claims 4, 14 and 24 are independently patentable over the cited references for at least these reasons.

Furthermore, Claim 8 recites, "wherein said step of selecting further comprises expanding a wild card property." Claims 18 and 28 contain corresponding system and program product recitations. As discussed with respect to Claim 4, nothing in the cited references discloses or suggests that at least one of the plurality of client properties is a wild card, thus, it also follows that none of the cited references discloses or suggests expanding the wild card property as recited in Claims 8, 18 and 28. Accordingly, Claims 8, 18 and 28 are independently patentable over the cited references for at least these reasons.

By way of further example, Claim 6 recites, "wherein said plurality of requested client properties includes at least one property that is designated as a mandatory property." Claims 16 and 26 contain corresponding system and program product recitations. As discussed above with respect to Claims 1, 11 and 21, nothing in the cited references discloses or suggests receiving a link element including a plurality of requested client properties, thus, it follows that nothing in the cited references discloses or suggests that at least one of the plurality of requested client properties is a designated as a mandatory property as recited in

Claims 6, 16 and 26. Accordingly, Claims 6, 16 and 26 are independently patentable over the cited references for at least these reasons.

Furthermore, Claim 10 recites "terminating the request if a mandatory property is not available to be transmitted." Claims 20 and 30 contain corresponding system and program product recitations. As discussed with respect to Claim 6, nothing in the cited references discloses or suggests that at least one of the plurality of client properties is designated as a mandatory property, thus, it also follows that none of the cited references discloses or suggests terminating the request based on the mandatory property not being available to be transmitted as recited in Claims 10, 20 and 30. Accordingly, Claims 10, 20 and 30 are independently patentable over the cited references for at least these reasons.

By way of further example, Claim 7 recites, in part:

wherein said step of inserting comprises the steps of:  
selecting ones of the plurality of requested client properties; and  
determining whether selected ones of the plurality of requested client  
properties are available to be transmitted.

Claims 17 and 27 contain corresponding system and program product recitations. As discussed above with respect to Claims 1, 11 and 21, nothing in the cited references discloses or suggests a link element including a plurality of requested client properties or inserting at least one of the requested client properties into a request. Thus, it follows that nothing in the cited references discloses or suggests details with respect to inserting the at least one requested client properties into the request. Accordingly, Claims 7, 17 and 27 are independently patentable over the cited references.

By way of final example, Amended Claim 9 recites:

The method of Claim 7, wherein said step of determining further comprises  
prompting a user whether to transmit the selected ones of the plurality of requested  
client properties.

Claims 19 and 29 contain corresponding system and computer program product recitations. As stated above, Claims 9, 19 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Gershman. The Office Action admits that Merriman does not specifically teach that the step of determining further comprises prompting a user whether to transmit said each one property as recited in Claim 9. *See* Office Action, page 5, paragraphs 28-30. The Office Action further admits that Heidorn

does not fully provide the missing teachings. *See id.* However, the Office Action points to the combination of Heidorn and Gershman to provide the missing teachings. *See id.* Applicants respectfully disagree.

Heidorn discusses "soft hyperlinks", *i.e.* a link that is not fully resolved when it is written. *See* Heidorn, column 3, lines 22-23. The cited portion of Heidorn discusses resolving soft hyperlinks by executing rules contained therein, but does not discuss prompting a user for permission to transmit information as recited in Claims 9, 19 and 29. *See* Heidorn, column 3, line 54 to column 4, line 34. Gershman discusses a system for displaying and retrieving information from the web using a handheld device. *See* Gershman, column 3, lines 14-29. The cited portion of Gershman discusses prompting the user to input information of interest to the user, but does not prompt the user for permission to transmit information as recited in Claims 9, 19 and 29. *See id.* Thus, the cited portions of Heidorn and Gershman do not disclose or suggest "prompting a user whether to transmit the selected ones of the plurality of requested client properties" as recited in Amended Claims 9, 19 and 29.

Accordingly, none of the cited references either alone or in combination disclose or suggest the recitations of at least the dependent claims set out above. Furthermore, there is no motivation or suggestion to combine the cited references as suggested in the Office Action. As recently affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

For example, with respect to Claims 9, 19 and 29 the Office Action states:

It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman and Heidorn with Merriman because a system [sic] have more versatility for a user that would want to utilize the system but would not want to divulge certain information that would be considered private and/or vital to a user, (*i.e.* cookies that might have credit card information, social security number). Having this option would make a user more likely to utilize the invention for its security reasons.

See Office Action, page 13. This motivation is representative of the motivations provided throughout the Office Action. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action. Accordingly, the statement in Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

For at least the foregoing reasons, Applicants respectfully submit that dependent claims discussed above are independently patentable over the cited references. Accordingly, Applicants submit that dependent claims are in condition for allowance, which is respectfully requested in due course.

#### **The New Claims are Patentable**

Applicants have added new Claims 31 through 36 to the present application. Applicants submit that these Claims are patentable over the cited references because nothing in the cited references discloses or suggests customizing the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties as recited in Claims 31, 33 and 35 or that at least one of the plurality of requested client properties is associated with hardware characteristics of the client as recited in Claims 32, 34 and 36.



### CONCLUSION

Applicants have amended Claims 8, 18 and 28 and submit that objections with respect to these claims have been obviated. Applicants further submit that Amended Independent Claims are patentable over the cited references for at least the reasons discussed above. Finally, Applicants submit that new Claims 31-36 are patentable over the cited references because the cited references fail to disclose or suggest many of the recitations of these claims. Accordingly, the pending claims are in condition for allowance, which is respectfully requested in due course.

It is not believed that an extension of time and/or additional fee(s), including fees for net addition of claims-are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 09-0461.

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